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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,319	03/06/2002	Tejaswini Hosali	YOR920010754US1	9034

7590 05/04/2005  
Samuel A. Kassatly  
6819 Trinidad Drive  
San Jose, CA 95120

EXAMINER

WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

**Application No.**

10/092,319

**Applicant(s)**

HOSALI ET AL.

**Examiner**

Stephan F Willett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim(s) 13, 14-15 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. pdf is/are acronym(s) and/or trademark(s), and thus are unclear. The claim(s) recites the limitation "the document" instead of a(n) document . There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim(s) 18-34 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d

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at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). The claims specify “computer program”, thus the software must be stored on a “computer-readable medium needed to realize the computer program’s functionality”, MPEP 2105.

***Claim Rejections - 35 USC 102***

1. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12, 14-28, 30-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Boucher et al. with Patent Number 5,884,246.

1. Regarding claim(s) 1, 18, 34, Boucher teaches translating emails, col. 3, lines 28-38. Boucher teaches parsing a document to retrieve variable data related to a destination language, col. 11, lines 44-46. Boucher teaches based on the parsed data selecting a destination language for the email and attachments, col. 11, lines 60-62; col. 9, line 45. Boucher teaches sending the email in the destination language with said variable data, col. 9, lines 31-34.

2. Regarding claim(s) 2, 10, 19, Boucher teaches sending emails to two addresses in two different languages col. 13, lines 5-12.

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3. Regarding claim(s) 3-4, 20-21, Boucher teaches verifying the language based on destination country, col. 12, lines 10-14; col. 9, line 42.
4. Regarding claim(s) 5, 15, 22, Boucher teaches verifying the language based on the communication language exchanged, col. 13, lines 47-49.
5. Regarding claim(s) 6, 23, Boucher teaches verifying the language based on the preferred destination address's language, col. 13, lines 3-5.
6. Regarding claim(s) 7, 9, 24, 26, Boucher teaches selecting an English language based default, col. 12, lines 2-3.
7. Regarding claim(s) 8, 25, Boucher teaches verifying the language based on destination country, col. 12, lines 10-14.
8. Regarding claim(s) 11, 27, Boucher teaches sending email based on product and services, col. 7, lines 66-67; col. 12, lines 26-30.
9. Regarding claim(s) 12, 28, Boucher teaches an attachment including a document, col. 9, line 44.
10. Regarding claim(s) 14, 30-31, Boucher teaches parsing a document to retrieve variable data triggered by an inquiry, i.e. to translate, col. 10, lines 46-49.
11. Regarding claim(s) 16-17, 32-33, Boucher teaches translating emails, col. 6, line 7 based on Internet addressing, col. 6, line 16.

***Claim Rejections - 35 USC 103***

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 13, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boucher et al. with Patent Number 5,884,246.

15. Regarding claim 13, 29, the Boucher patent discloses the method of the preceding claims. The Boucher patent does not explicitly disclose the data relating to a pdf document. However, Official Notice is taken MPEP 2144.03 (a)) that using pdf documents is well known in the art to insure diverse communication capability. It would have been obvious to one of ordinary skill in the art at the time of the application's invention to use a pdf document to obtain the advantages of communicating with compatible forms of data. By the above rationale, the claim is rejected.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is

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suggested. A close review of the Stringham et al. reference with Patent Pub. No. US 2002/0188670 is suggested. The other references cited teach numerous other ways to translate emails, thus a close review of them is suggested.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (571) 272-3890. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

6. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



Stephan Willett

Patent Examiner

April 29, 2005